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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/612,404	07/07/2000	Gerard F. Barry	MONY:140	6845

7590 03/27/2002
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EXAMINER

RAO, MANJUNATH N

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 03/27/2002

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/612,404

Applicant(s)

BARRY ET AL.

Examiner

Manjunath N Rao

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 19 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☒ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Claims 1-20 are still at issue and are present for examination. Claims 19 and 20 remain withdrawn from consideration as being drawn to non-elected invention.

Applicants' arguments filed on 12-19-01, paper No. 11, have been fully considered and are deemed to be persuasive to overcome some of the rejections previously applied. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn.

Amendments

The amendment filed 12-19-01, paper No.11 proposes amendments to specification and the claims that do not comply with 37 CFR 1.173(b), which sets forth the manner of making amendments in reissue applications. A supplemental paper correctly amending the reissue application is required.

Oath/Declaration

In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Claims 1-18 are rejected as being based upon a defective reissue Declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

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Sequence Compliance

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth below.

This application does not contain, as a separate part of the disclosure on paper copy, a "Sequence Listing" as required by 37 C.F.R. 1.821(c).

A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 C.F.R. 1.821(e).

Surrender of original patent

Examiner has observed that the Patentee(s) have only "offered" to surrender the original patent 5, 776,760. The original patent has to be either fully surrendered, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

Litigation of the original patent

Examiner has noted that applicants informed the Office that the original patent 5,776,760 is subject to litigation during the month of January 2001. However, applicants have not updated about the outcome of this litigation. Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 5,776,760 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-3, 5-6, 8, 9, 11-12, 14-15, 17-18 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for DNA with SEQ ID NO:4, 6, 7, 8 and 17 encoding a protein having glyphosate oxidoreductase activity, does not reasonably provide enablement for any DNA that is capable of hybridizing to the above SEQ IDs under any hybridization conditions. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. See previous Office action for rejection.

In response to the previous Office action, applicants have rejected the above claims arguing that the Examiner's rejection is based on an erroneous construction because the claims do not read on just any DNA but on DNA molecules capable of hybridizing to a specific probe and exhibiting a specific function. Examiner respectfully disagrees. Applicants claims are drawn to any DNA that can hybridize under any condition and encode a polypeptide with a

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glyphosate oxidoreductase (GOR) activity. While applicants have added the limitation of hybridization, they have not defined the hybridization condition limitation, rendering the scope of the claims to be so broad that it reads on any DNA encoding GOR activity.

Applicants also argue that it would not require undue experimentation for one of ordinary skill in the art to determine the proper hybridization conditions. Again Examiner respectfully disagrees. While the art provides information as to how to perform hybridization reactions (e.g. Maniatis et al.), because of several factors involved in a hybridization reaction such as the level of homology between the probe and the target DNA, salt concentrations which influence the hybrid formation etc., unless the hybridization conditions are defined it would still be undue experimentation for one of skill in the art.

Applicants also argue that Examiner's argument regarding PCR conditions and hybridization conditions to be a misperception that obtaining genes encoding GOR must result from a hybridization-based approach and that applicants submit that the instant application which reports the cloning of a number of GOR genes is fully enabled. Again, Examiner respectfully disagrees. While the application is enabled for those genes which have been characterized by SEQ ID NO, the specification is not enabling for those DNA molecules that simply hybridize to the characterized polynucleotides with SEQ ID No, under any conditions. This is because claims are very broadly drawn to an extremely large number of polynucleotides encoding GOR.

Applicants go on to argue that they have provided a functional assay through which the isolated clones can be tested for activity and that the application is enabled. Again, even though applicants have provided assays for screening the isolated clones, the claims are rejected simply

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because they are very broad and encompass any DNA sequence encoding a polypeptide with GOR activity from any source. Therefore, the above rejection is maintained.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer (TD) signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 13-15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 13 of U.S. Patent No. 5,463,175. Although the conflicting claims are not identical, they are not patentably distinct from each other because Claims 13-15 of the instant application claims the same SEQ ID NO:8 claimed in claim 13 of the patent.

In response to the previous Office action, applicants have traversed the above rejection arguing that they have already provided such a TD in the original patent that is being reissued for the very same reference and hence it is inappropriate for the Examiner to request the filing of yet another TD at this time. However, a new TD is required for allowance of this reissue

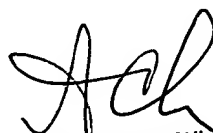
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application. Furthermore, the assignee of this reissue application and the assignee of the original patent appears to be different and at least for that reason a new TD is required. Hence until a proper TD is filed the above rejection will be maintained.

Conclusion

Claims 4, 7, 10, 13 and 16 are allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manjunath Rao whose telephone number is (703) 306-5681. The Examiner can normally be reached on M-F from 6:30 a.m. to 3:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, P.Achutamurthy, can be reached on (703) 308-3804. The fax number for Official Papers to Technology Center 1600 is (703) 305-3014. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.


PONNATHAPUACHUTAMURTHY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

Manjunath N. Rao. Ph.D.
March 25, 2002